



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PO BOX 1450, ALEXANDRIA, VA 22313-1450  
WWW.USPTO.GOV

JUL 2 2003

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK NY 10112

# 21

In re Application of :  
Yutaka Takano et al :  
Serial No.: 09/496,041 : WITHDRAWAL OF ABANDONMENT  
Filed: February 2, 2000 :  
Attorney Docket No.: :

This is in response to the petition under 37 CFR 1.181, filed April 24, 2003, requesting withdrawal of the holding of abandonment of the above identified application.

A review of the file history shows that the Office mailed a non-Final Office action to applicants on August 13, 2002, setting a three month shortened statutory period for reply. This was a first Office action following the filing of a CPA request which was granted. Applicants replied on February 13, 2003, by filing a request for a three month extension of time, a Request for Continued Examination (RCE) and a request for suspension of action and the fees for all of the requests.

37 CFR 1.114 states as follows:

- (a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:
  - (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
  - (2) Abandonment of the application; or
  - (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.
- (b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

As noted above the filing an RCE is permitted only when prosecution in an application is closed and the application has a filing date later than May 29, 2000. The earlier filed CPA established the filing date on which an RCE may be based. However, the RCE filing was improper as the application prosecution was not closed. Since the filing occurred on the last day of the six month statutory period for filing a reply to an Office action and no reply to the Office action accompanied the RCE papers, the application was held abandoned. The request for a three month suspension of prosecution could not be granted as (a) the RCE was not grantable and (b) a suspension of action cannot be granted when applicant is under an obligation to reply to an

outstanding Office action. Thus the application was properly held abandoned. Applicants are entitled to a refund of the fees paid in error for the RCE and suspension of action.

Applicants' attachments to the petition requesting the filing of a continuing application will not be acted on. Such requests should be filed separately to "Mail Stop: New Application". Further, in order to establish copendency between this application and any continuing application a petition under 37 CFR 1.137(b) must be filed in this application for that purpose.

Applicants' petition is **DENIED**.

**Alternatively, applicant may revive this application only by filing a petition under 37 CFR 1.137(b). Any such renewed petition must be filed within TWO MONTHS of the mailing date of this decision and must be accompanied by a reply to the outstanding Office action.**

**The fee paid for filing RCE papers of \$750.00 and for suspension of action of \$130.00 will be credited to applicants' Deposit Account No. 06-1205, as directed. (The fee for the extension of time is not refundable as it was not paid in error.)**

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.



Bruce M. Kisliuk  
Director, Technology Center 1600